

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-10 are currently pending in the present application, Claims 1, 5, and 8-10 having been amended by way of the present amendment. No new matter has been added.<sup>1</sup>

In the outstanding Office Action, Claims 8-10 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter; Claims 1 and 3-4 were rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over Claim 1 of co-pending application Serial No. 10/519,833; and Claims 1-10 were rejected under 35 U.S.C. § 103(a) as unpatentable over Masaharu (JP 2003-029795 A, hereinafter “Masaharu”) in view of Applicant’s Figure 3, and further in view of Kato (U.S. Pat. Pub. No. 2004/0213552, hereinafter “Kato”).

Regarding the rejection of Claims 8-10 under 35 U.S.C. § 101, Applicant has amended these claim to recite a computer readable medium in view of MPEP § 2106, and to embrace aspects of a data transferring system. Because Claims 8-10 recite a machine, Applicant respectfully submits that Claims 8-10 are directed to statutory subject matter. Accordingly, Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. § 101.

Regarding the provisional rejection of Claims 1, 3, and 4 on the grounds of non-statutory double patenting over Claim 1 of co-pending application number 10/519,833, Applicant respectfully requests that this rejection be held in abeyance until the present application is in condition for allowance for the following reasons. A terminal disclaimer can be filed, if the claims in the present application remain obvious in view of the claims of the cited U.S. patent application (10/519,833) at the time of allowance of the present application.

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<sup>1</sup> Support for the amendments to Claims 1, 5, and 8 is found at least at page 94, lines 13-14, page 107, lines 19-22, and in Fig. 49.

Furthermore, additional amendments (if needed for allowance of these claims) may eliminate the double-patenting rejection, making the filing of a Terminal Disclaimer at this time premature. Indeed, M.P.E.P. § 804.02 IV states that, prior to issuance, it is necessary to disclaim each one of the double patenting references applied. Hence, Applicant respectfully requests that the examiner contact the undersigned should the present amendments and arguments be accepted and should the present application be otherwise in condition for allowance. At that time, a terminal disclaimer, if warranted, can be supplied to expedite issuance of this case.

Regarding the rejection of Claims 1-10 under 35 U.S.C. §103(a) as unpatentable over Masaharu (JP 2003-029795) and in view of Fig. 3 of background art and Kato, Applicant respectfully traverses the rejection.

Claim 1 defines a data transferring system for transferring audio data between a first recording medium and a second recording medium, *without destruction of a data structure of the audio data*. The data transferring system includes:

a plurality of first sets defining albums, each of which includes at least one track of audio data, *the albums being correlated with a plurality of content ID's identifying audio data that has been recorded on the first recording medium*;

a second set, defining a play list *linked to the plurality of content ID's*, that describes the reproduction order of audio data contained in at least one first set and recorded in the first recording medium and that describes pointers to tracks of audio data contained in each of the first sets; and

controlling means for transferring all tracks of audio data contained in the first sets that contain audio data described in the second set from the first recording medium to the second recording medium *without destruction of a data structure of the audio data*, when audio data described in the second set are transferred to the second recording medium, wherein

*the same data structure of audio data on first recording medium side is formed on the second recording medium based on the link between the play list and the plurality of content ID's.*<sup>2</sup>

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<sup>2</sup> Emphasis added.

For example, as described on page 11 of Applicant's specification, the claimed data transferring system allows a transferring operation for contents to transferred without destruction of a data structure of the audio data.

However, the art of record does not disclose or suggest transferring audio data between a first recording medium and a second recording medium, without destruction of a data structure of the audio data. Indeed, Applicant respectfully submits that Masaharu, Applicant's Fig. 3, and Kato are silent regarding transferring all tracks of audio data contained in the first sets that contain audio data described in the second set from the first recording medium to the second recording medium without destruction of a data structure of the audio data, when audio data described in the second set are transferred to the second recording medium. Further, Masaharu, Applicant's Fig. 3, and Kato do not disclose or suggest "the same data structure of audio data on first recording medium side is formed on the second recording medium based on the link between the play list and the plurality of content ID's," as recited in Claim 1.

M.P.E.P. § 2143.03 requires, to establish a case of *prima facie* obviousness, that all words in a claim must be considered in judging the patentability of the claim against the prior art. Further, M.P.E.P. § 2123 I states that a reference may be relied on for all it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments.

Therefore, Applicant respectfully submits that Masaharu, Applicant's Fig. 3, and Kato do not anticipate or make obvious the features of amended Claim 1. Therefore, independent Claim 1 (and the claims dependent therefrom) is believed to patently define over Masaharu, Applicant's Fig. 3, and Kato.

Independent Claims 5 and 8, while differing in scope and statutory class from Claim 1, patentably define over Masaharu in view of the background art and Kato for substantially

the same reasons as Claim 1. Accordingly, it is respectfully submitted that Masaharu, the background art and Kato do not anticipate or render obvious the features of independent Claims 5 and 8. Therefore, independent Claims 5 and 8 (and the claims dependent therefrom) are believed to patentably define over Masaharu, the background art, and Kato.

Consequently, in view of the present amendment and in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

  
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Bradley D. Lytle  
Attorney of Record  
Registration No. 40,073

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 08/07)